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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/054,337 | 01/22/2002 | Craig D. Johnson | 68.0233 | 4747 |

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EXAMINER

WALKER, ZAKIYA NICOLE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3672

DATE MAILED: 06/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,337

Applicant(s)

JOHNSON ET AL.

Examiner

Zakiya N. Walker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8-10,14-16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 2-7,11-13 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 15 and 17 are objected to because of the following informalities: Claims 15 and 17 recite the limitation "the openings" in lines 2 and 1, respectively. There is insufficient antecedent basis for this limitation in the claim. The term should be replaced with --the at least one opening--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Sparlin et al.

Sparlin et al. discloses a well screen that includes a base pipe 2 having at least one hole 2a, a filter 5, a plurality of splines 6, and a rod 3. The reference further teaches the rods adjustably placed, and the filter itself acts as an erosion inhibitor by preventing harsh downhole elements from eroding the pipe.

4. ^{Claim} 10, 14-16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornette et al.

Cornette et al. discloses a screen that includes a base pipe 40 having a plurality of holes, and a sleeve 41 having at least one opening. The reference further teaches the sleeve adjustably placed, and a filter 21 acts as an erosion inhibitor by preventing harsh downhole elements from eroding the pipe.

Allowable Subject Matter

5. Claims 2-7, 11-13, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Further, the objection to claim 17 (in paragraph 1 above) must be corrected in order to be allowable.

Response to Arguments

6. Applicant's arguments filed 4/11/03 have been fully considered but they are not persuasive with respect to the independent claims. With respect to claim 1, the applicant argues that the Sparlin et al. reference does not suggest a rod "to selectively cover" the hole. However, such an action limitation ("to_") is considered functional language, which is not germane to the patentability of apparatus claims. With respect to claims 10 and 20, applicant argues that the Cornette et al. reference fails to teach that the sleeve is rotated "to vary the fluid communication" (claim 10), and though the remarks were silent to claim 20, the applicant may argue that the size of holes were not chosen "to produce a predetermined flow pattern" (claim 20). However, each action

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limitation ("to_") is considered functional language, which is not germane to the patentability of apparatus claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (703) 305-0302. The examiner can normally be reached on Monday-Thursday, 6:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3597 for regular communications and (703) 746-3826 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



Zakiya N. Walker
Examiner
Art Unit 3672

ZW
June 18, 2003